

**REMARKS****I. Preliminary Matters**

This Preliminary Amendment is submitted with the continuation application that claims priority to application serial number 09/514,833. Claims 1-42 were filed in the parent application. After an interview with the Examiner concerning the parent application on September 10, 2003, Applicants hereby submit this preliminary amendment with a continuation application whereby claims 1-42 are cancelled and new claims 43-95 are introduced. In an Office Action dated July 18, 2003 for the parent application, the Examiner raised the following issues:

- The drawings are objected to under 37 CFR 1.83(a), as the steps as claimed in claims 24-27 and 31 must be shown or the features cancelled from the claims;
- Claims 24-27 and 31 are rejected under 35 U.S.C. § 101 because the disclosed invention is inoperative and therefore lacks utility;
- Claims 1, 4, 8, 12, 15-17, 23, 32-34, and 37-43 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Number 6,144,671 to Perinpanathan et al. (hereinafter *Perinpanathan*) as stated by paragraph 10 in the Office Action dated February 13, 2003;
- Claims 3 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Perinpanathan* in view of Applicants' admission of prior art as stated by paragraph 14 in the Office Action dated February 13, 2003;
- Claims 24-27 and 31 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention;
- Claims 24-27 and 31 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention; and
- Claims 24-27 and 31 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

## **II. Summary of Examiner Interview Regarding Parent Application**

An interview was conducted between the Examiner and Applicants' representatives (R. Ross Viguet, 42,203 and Andrew Vicknair, 53,721) on September 10, 2003. The participants discussed the 35 U.S.C. § 101 and § 112 rejections. The objection to the drawings were also discussed whereby Applicants submit new drawing FIGURE 4 to overcome the Examiner's objection. Claim 1 was also discussed in view of *Perinpanathan*. No agreement was reached concerning the Examiner's reading of claim 1 in view of the prior art.

## **III. Claim Amendments**

Claims 1-42 are cancelled and new claims 43-95 have been submitted. No new matter is introduced by new claims 43-95 as support for all new claims exists in the specification as shown below:

### **Independent Claims**

New independent claims 43 and 60 recite subject matter similar to claims 1 and 15 of the parent application further amended to clarify that communication information, originally directed to a remote terminal, for use in accessing an application is redirected to the home system as shown in the specification at (page 5, lns 10-20 and page 11, lns 3-6).

New independent claim 72 recites subject matter similar to claim 24 of the parent application further amended to clarify that the user terminals use a server to access some functions of the home system that are available to the user terminal only through the use of the server due to the limited processing power of the user terminal as shown in the specification at (page 13, lns 4-14).

New independent claim 78 recites subject matter presented in claim 39 of the parent application. New independent claim 86 is supported in the specification as shown at (page 5, lns 10-26; page 8, lns 10-16; page 9, lns 4-7; and page 11, lns 3-6). New independent claim 95 is also supported by the specification as shown at (page 8, lns 12-20; page 10, lns 5-14; page 11, lns 3-10; and FIGURE 2). No new matter is added by the claim amendments.

**Dependent Claims**

Claims 44-48 recite subject matter represented in claims 3-11 of the parent application. Claims 49-51 claim subject matter related to various applications as shown in the specification at (page 10, lns 5-14). Claims 52 and 53 recite subject matter related to a user profile as shown in the specification at (page 5, lns 20-26, and page 6, lns 1-3). Claims 54 and 55 recite subject matter represented in claims 33 and 37 of the parent application. Claim 56 recites aspects related to providing functionality not directly available to the remote terminal as shown in the specification at (page 13, lns 4-14). Claim 57 recites subject matter represented in claim 12 of the parent application. Claims 58 and 59 recite subject matter represented in claim 32 of the parent application. Claim 61 recites subject matter represented in claim 16 of the parent application. Claim 62 recites subject matter represented in claims 20-22 of the parent application. Claim 63 recites subject matter represented in claim 17 of the parent application. Claim 64 recites subject matter represented in claim 23 of the parent application. Claims 65-67 recite aspects related to local applications of a server as shown in the specification at (page 9, ln 10 to pg 10, ln 14 and page 12, lns 11-15). Claim 68 recites subject matter represented in claim 15 of the parent application. Claim 69 recites subject matter represented in claim 18 of the parent application. Claim 70 recites subject matter represented in claims 18 and 19 of the parent application. Claim 71 recites aspects related to the various data formats as shown in the specification at (page 8, lns 20-22). Claims 73-77 recite subject matter represented in claims 25-31 of the parent application. Claims 79-82 recite subject matter represented in claims 40-43 of the parent application. Claims 83-85 recite aspects related to various applications as shown in the specification at (page 10, lns 5-14). Claim 87 recites subject matter recited in claim 17 of the parent application. Claims 88 and 89 recite aspects related to a visual display of a remote terminal as shown in the specification at (page 11, lns 1-14). Claims 90, 91, and 93 recite aspects related to external data resources as shown in the specification at (page 12, lns 4-12). Claim 92 recites subject matter related to various applications as shown in the specification at (page 10, lns 5-14). Claim 94 recites aspects related to the user profile as shown in the specification at (page 5, lns 14-26). As such, the specification provides support for all dependent claims, and therefore no new matter is added by the claim amendments.

**IV. Specification Amendments**

Applicants would like to make clear that three new paragraphs have been added to the specification. The first new paragraph cross references and claims priority to the parent application. The second new paragraph simply lists FIGURE 4 in the “Brief Description of Drawings” section on page 7. The third new paragraph has been added to describe new FIGURE 4. These new paragraphs contain no new matter, as the wording of the third paragraph to describe FIGURE 4 was taken straight from claims 24-27 and 31 of the parent application.

**V. Previous Drawing Objection**

The Examiner objected to the drawings under 37 CFR 1.83(a) stating that the drawings must show every feature of the invention specified in the claims, and the steps as claimed in claims 24, 25, 26, 27, and 31 of the parent application must be shown or the features cancelled from the claims. In response to the Examiner’s objection, Applicants have added FIGURE 4 to obviate the Examiner’s objection by showing the method steps as claimed in new claims 72-77. Applicants submit that the drawings comply with 37 CFR 1.83(a) and that the features of new claims 72-77 are shown in the drawings.

**VI. Previous Rejection under 35 U.S.C. § 101**

The Examiner rejected claims 24-27 and 31 of the parent application under 35 U.S.C. § 101 stating that the disclosed invention is inoperative and therefore lacks utility. The Examiner states that the wording of claim 24 of the parent application which states, “user terminals use said server to access functions of a home system not available to the user terminal” makes the access functions unavailable to the user terminal which in turn makes it impossible for the user terminal to access the functions through the server. New claim 72 recites, “wherein said user terminals use said server to access functions of a home system that are available to said user terminals only through the use of said server.” As claimed, it is no longer impossible for the user terminals to access the functions of the home system. The invention claimed in new claims 72-77 is operative and overcomes the previous 35 U.S.C. § 101 rejection.

**VII. New Claims Are Patentable Over Previously Cited References****35 U.S.C. § 102(e) Rejection--- *Perinpanathan***

Claims 1, 4, 8, 12, 15-17, 23, 32-34, and 37-43 of the parent application were rejected under 35 U.S.C. § 102(e) as being anticipated by *Perinpanathan* as stated by the parent Office Action dated July 18, 2003.

It is well settled that to anticipate a claim, the reference must teach every element of the claim. *See* M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. section 102 with respect to a claim, “[t]he elements must be arranged as required by the claim.” *See* M.P.E.P. § 2131, *citing In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Applicants respectfully assert that the disclosure of *Perinpanathan* does not teach all the elements of claims 43-95 nor does *Perinpanathan* show the elements arranged as required by the claims. Therefore, claims 43-95 are patentable over *Perinpanathan*.

**A. Failure to show claims arranged as required by claim****1. Independent Claims****Claims 43 and 60**

Claim 43 recites, in part:

at least one home system associated with a subset of said terminals wherein at least one of said terminals is remote from said at least one home system, said home system including a distribution system for selectively accessing a plurality of applications;

said remote terminal including a communication information rerouting system for redirecting a portion of communication information, which had been originally directed to said remote terminal, for use in accessing an application of said plurality of applications to said at least one home system associated with said remote terminal;

Claim 60 recites, in part:

at least one server associated with a plurality of applications, said server further associated with at least a subset of said terminals, wherein at least one terminal is remote from said server;

said remote terminal includes an information routing system for redirecting a portion of communication information, originally directed to said remote terminal, for use in accessing an application of said plurality of applications to said at least one a server associated with said remote terminal.

*Perinpanathan* fails to teach these elements arranged as required by claims 43 and 60. *Perinpanathan* teaches a method which allows a callee having a personal host connected to a home network to receive at a foreign host connected to the network a multimedia call, from a calling host, originally directed to the personal host. (*Perinpanathan*, Col. 2, lns 17-24).

This method involves a call redirector running on the personal host that responds to a call setup request sent by a caller to the callee's personal host. (*Perinpanathan*, Col. 6, lns 52-62). In response to a call setup request by a caller, the call redirector will initiate a call setup reply to the caller host indicating the new care/of address at which the mobile callee can be reached. (*Perinpanathan*, Col. 6, lns 62-67). The caller host receives this call setup reply and recognizes the need to send a second call setup request to the care/of address instead of the personal host. (*Perinpanathan*, Col. 6, ln 65 to Col. 7, ln 5).

Thus, *Perinpanathan* teaches a method in which a call redirector responds to the initiator of a call with the current address of the callee, but there is no disclosure or teaching of redirecting communication information, which was originally directed to a remote terminal, for use in accessing an application of a plurality of applications to a home system or server. The redirector of *Perinpanathan* does not redirect communication information that was originally directed to a remote terminal to the home system as required by claims 43 and 60. Rather, the redirector initiates a new call and sends the new address information to the caller. Thus, there is no redirection of communication information, originally sent to a remote terminal, for use in accessing an application from a plurality of applications to a home system. Therefore, *Perinpanathan* fails to teach or suggest the arrangement in which a remote terminal redirects communication information, originally directed to the remote terminal, for use in accessing an application from a plurality of applications to a home system. Thus, claims 43 and 60 are patentable over *Perinpanathan*.

## **B. Failure to Teach Every Element of the Claim**

### **1. Independent Claims**

#### **Claim 72**

Claim 72 recites, in part:

associating at least one server with a plurality of user terminals over a communication network wherein said user terminals use said server to access functions of a home system that are available to said user terminals only through the use of said server.

*Perinpanathan* fails to teach a method where the user terminals use a server to access functions of a home system where the functions are available to the user terminal only through the use of the server. *Perinpanathan* teaches a method for allowing a callee to receive a call at a foreign host from a calling host originally directed to the personal host (Col. 2, lns 17-30); a method for a callee to receive a call at a mobile host that was originally directed to the personal host (Col. 2, lns 32-39); and a method for distributing multimedia calls among a plurality of computing devices (Col. 2, lns 47-63). However, there is no teaching of a user terminal accessing a server for the purpose of accessing functions that are available to the user terminal only through the use of a server. As such, the cited reference fails to teach each and every element of claim 72. Thus, claim 72 is patentable over *Perinpanathan*.

**Claim 78**

Claim 78 recites, in part:

a plurality of applications available to said devices, said availability being controlled by said local system;

*Perinpanathan* fails to teach a communication system wherein control of availability to a plurality of applications is controlled by a local system. *Perinpanathan* states that the terminal mobility according to the invention not only allows the end-user greater control and ability to customize how and where his/her calls are to be redirected but allows this service to be packaged through proper interfaces. (Col. 3, lns 24-31). Additionally, *Perinpanathan* teaches that the call redirector is interfaced with a base service, so that a user can control the actions of the redirector. (Col. 6, lns 1-5). However, the control stated refers to control by an end user and control over the actions of a redirector, but there is no mention of control of application availability by a local system.

Claim 78 further recites:

means for extending the operation of said means for allowing any such devices to selectively access any of said applications to a select set of communication terminals remote from said local system.

There is no mention in *Perinpanathan* of a means for extending operation to a select set of terminals remote from said local system as specified in claim 78. Element (#200) of

*Perinpanathan* was recited by the Examiner in the parent Office Action dated July 18, 2003 as a communication information rerouting system which receives set-up requests and then sends a call set-up request to a terminal. (Col. 17, lns 40-43). However, this does not teach the extending of operations to a select set of remote terminals. *Perinpanathan* teaches a personal mobility method to allow a callee to receive a call at a foreign host from a caller who directed the call to the local host (Col. 2, lns 17-31), and provides for terminal mobility which allows a callee having a mobile host that is normally connected to a home network to receive calls at a mobile host from a calling host originally directed to the personal host. (Col. 2, lns 32-46). This disclosure relates to the redirection of calls to a mobile terminal, but there is no teaching of extending the operation of selectively accessing applications to communication terminals remote from the local system as claimed in claim 78. As such, *Perinpanathan* fails to teach each and every element of claim 78. Thus, claim 78 is patentable over *Perinpanathan*.

#### **Claim 86**

Claim 86 recites, in part:

at least one server system having a plurality of local applications, said server system further having a user profile of said remote terminal available to an application of said plurality of applications;

said server system operable to access said user profile searching for information associated with said redirected information wherein upon locating said information said server sends said located information to said remote terminal.

*Perinpanathan* fails to teach a server system having a user profile of a remote terminal that is available to an application of a plurality of applications. In addition, *Perinpanathan* fails to teach a server system that can access a user profile to search for information associated with information that was redirected by a remote terminal and fails to teach sending the information to the remote terminal upon locating the information.

*Perinpanathan* teaches a call redirector running on the personal host that responds to a call setup request sent by a caller to the callee's personal host. (*Perinpanathan*, Col. 6, lns 52-62). In response to a call setup request by a caller, the call redirector will initiate a call setup reply to the caller host indicating the new care/of address at which the mobile callee can be reached. (*Perinpanathan*, Col. 6, lns 62-67). However, *Perinpanathan* fails to teach a user profile of a remote terminal and fails to teach accessing the user profile to search for



information as recited in claim 86. As such, *Perinpanathan* fails to teach each and every element of claim 86. Thus, claim 86 is patentable over *Perinpanathan*.

#### **Claim 95**

Claim 95 recites, in part:

a plurality of applications for providing communication or information services, said plurality of applications including at least one application selected from the group consisting of a conference call application, a number retrieval application, an information update application, a voice-mail application, and a pager application; at least one home system associated with a cellular telephone of said plurality of cellular telephones, wherein said home system provides application processing using said plurality of applications in response to communications redirected by said cellular telephone, thereby providing functionality of one or more applications of said plurality of applications to one of said plurality of cellular telephones.

*Perinpanathan* fails to teach these elements of claim 95. *Perinpanathan* teaches a call redirector method for allowing a callee to receive a call at a foreign host from a calling host originally directed to the personal host (Col. 2, lns 17-30); a method for a callee to receive a call at a mobile host that was originally directed to the personal host (Col. 2, lns 32-39); and a method for distributing multimedia calls among a plurality of computing devices (Col. 2, lns 47-63). However, *Perinpanathan* fails to teach a conference call application, a number retrieval application, an information update application, a voice-mail application, or a pager application. In addition, *Perinpanathan* fails to teach a home system associated with a cellular telephone where the home system provides application processing from a conference call application, number retrieval application, an information update application, a voice mail application or a pager application in response to communications redirected by the cellular telephone. As such, *Perinpanathan* fails to teach each and every element of claim 95. Thus, claim 95 is patentable over *Perinpanathan*.

## **2. Dependent Claims**

### **Claims 44-59, 61-71, 73-77, 79-85, and 87-94**

Claims 44-59, 61-71, 73-77, 79-85, and 87-94 depend directly or indirectly from their respective base claims 43, 60, 72, 78, and 86 and thereby inherit all of the respective

limitations. Thus, Applicants respectfully submit that based on the arguments above, claims 44-59, 61-71, 73-77, 79-85, and 87-94 are patentable over *Perinpanathan*.

#### **VIII. 35 U.S.C. § 112 Rejection, first paragraph—written description**

Claims 24, 25, 26, 27, and 31 of the parent application, which correspond to new claims 72-77, were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the invention was filed, had possession of the claimed invention.

Applicants have added FIGURE 4 and a new specification paragraph to describe FIGURE 4 in response to the Examiner's drawing objection. FIGURE 4 is a flow chart that represents the method claims as claimed in claims 72-77. The addition of FIGURE 4 and the added specification paragraph clearly show that claims 72-77 are fully supported by the specification.

#### **IX. 35 U.S.C. § 112 Rejection, first paragraph—enablement**

Claims 24, 25, 26, 27, and 31 of the parent application were also rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The standard for determining whether the specification meets the enablement requirement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. MPEP 2164.01 citing *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988).

Claim 72 clarifies that the user terminals use a server to access function of a home system that are available only through the use of the server, and thus it is not impossible for the user terminals to access the functions of the home system as stated by the Examiner in the parent Office Action mailed July 18, 2003. Therefore, the invention claimed in claims 72-77 is operative. Claim 72 is supported by the new specification paragraph and at (page 13, lns 4-14). With the addition of FIGURE 4 and the new specification paragraph, claim 72 is supported by a utility and is described in the specification in such a way as to enable one skilled in the art to make and/or use the invention without undue experimentation.

**X. 35 U.S.C. § 112 Rejection, second paragraph--indefinite**

Claims 24-27 and 31 of the parent application were also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out an distinctly claim the subject matter which the applicant regards as the invention.

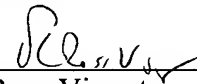
As submitted, claim 72 accurately and precisely defines the invention claimed in claim 24 of the parent application. Claim 72 clarifies the previous language of claim 24 of the parent application so that it is no longer impossible for the user terminals to access the functions of the home system.

**XI. Summary**

In view of the above, each of the claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. The fee due with this application is enclosed herein.

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Respectfully submitted,

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